

**REMARKS**

Applicant has studied the Office Action dated February 10, 2005. It is submitted that the application, as amended, is in condition for allowance. Claims 1-15 and 17 remain pending. Claims 1, 3, 9, 11, 12, and 17 are amended. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (4) acknowledged and accepted the declaration filed on October 14, 2004 under 37 CFR § 1.131 removing the Kelley et al. reference;
- (6) withdrew the Examiner's rejection to claims 9 and 15 under USC § 112, 2<sup>nd</sup> paragraph;
- (7) withdrew the Examiner's rejection to claim 16 under USC § 101;
- (8-9) rejected claims 1, 3-12, 14, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Payne et al. (U.S. Patent No. 5,715,314) in view of Fawcett (U.S. Patent No. 5,845,077); and
- (10) rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Payne et al. (U.S. Patent No. 5,715,314) in view of Fawcett (U.S. Patent No. 5,845,077) and further in view of Klemba et al. (U.S. Patent Pub. No. 2002/0128975 A1).

**(4) Declaration under 37 CFR § 1.131**

The Applicant wishes to thank Examiner Roche for accepting the declaration filed on October 14, 2004 under 37 CFR § 1.131 removing the Kelley et al. reference as prior art. Although the Examiner has accepted the previously filed declaration, the Applicant has filed with this response a 1.131 Supplemental Declaration to place supplemental information in the file history to evidence that the above-referenced patent application was reduced to a writing and reduced to practice before the priority date of the Kelley et al. reference.

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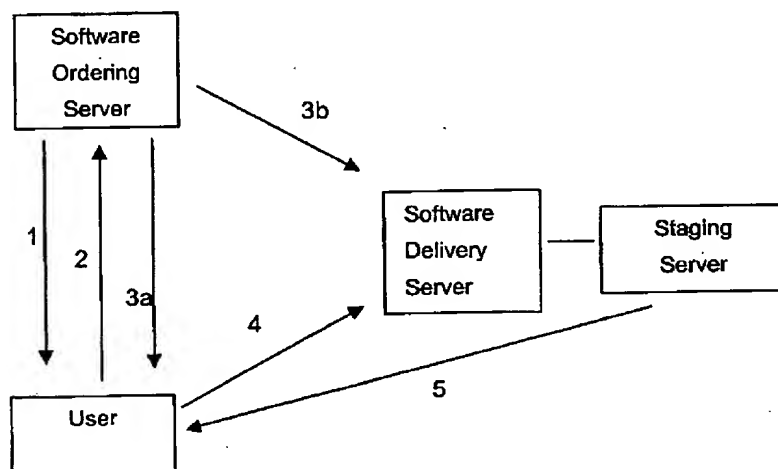
(6) Rejection under USC § 112, 2nd paragraph

The Applicant wishes to thank Examiner Roche for withdrawing the rejection to claims 9 and 15 under USC § 112, 2<sup>nd</sup> paragraph, in light of Applicant's previous amendments to claims 9 and 15. It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs.

Overview of the Present Invention

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. The following figure and brief description is intended to further clarify the features of the present invention.

The present invention, shown below, is a method, computer readable medium, and system for the central management, delivery, and installation of media-less software.



In step 1, a user is presented, by a software ordering server, with a list of software available on the software ordering server. See page 13, first para., FIG. 7, and claim 1 of the instant application. In step 2, the user communicates to the software ordering server, an order for at least one software file from the list of available software. See page 9, second para., FIG. 3, and claim 1 of the instant application. In the third step, which is a two-part step and is shown as 3a and 3b in the figure above, the software ordering server communicates a response to the user (3a) that the user's request for

software has been received. *Ibid.* The response contains an entitlement ID, that is an encrypted code that is later used by the user to obtain the software file from a server other than the software ordering server. In the second part of the third step (3b), the software ordering server also sends the same entitlement ID to a software delivery server. *Ibid.* In the fourth step, the user requests from the software delivery server a copy of the selected software file by communicating the entitlement ID along with the request for software delivery to the software delivery server. *Ibid.* In the fifth and last step, the software delivery server compares the entitlement ID received from the user to the entitlement ID received from the software ordering server in step 3b and sends instructions to a scheduling server to schedule the forwarding of a copy of the requested software from a staging server, which holds the software files, to the user in response to the two entitlement IDs matching.

Independent claims 1, 9, 11, 12, 15, and 17 are completely consistent with the above figure and description and read, in part, as follows. Step numbers have been added to the claims to help map the claim steps to the figure above. Claims 9, 11, 15, and 17 are from the perspective of the software delivery server and, thus, begin at step 3b.

**Claim 1:**

...  
presenting to a user a list of software for installation on a client system; **[1]**  
receiving a user selection for ordering at least one software file from the list of software on a software ordering server; **[2]**  
receiving a response to the order for at least one software file from the software ordering server, the response includes an entitlement ID for authorizing the installation of the software file, wherein the entitlement ID is sent from the software ordering server to the software delivery server; **[3a and 3b]**  
requesting a download copy of the at least one software file from the software delivery server, the request includes the entitlement ID previously received from the software ordering server; **[4]**  
receiving, in response to the entitlement ID received from the software ordering server matching the entitlement ID received with a request for the download copy, the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script; and

installing the received copy of the at least one software file.

**[5]**  
(indicator numbers added)

Claim 9:

...  
receiving from a software ordering server, an entitlement ID for authorizing the installation of at least one software file which has been previously ordered on a client system; **[3b]**  
receiving a request from the client system for the download of a copy of the at least one software file to the client system, wherein the request includes an entitlement ID used to order the software file; **[4]**  
verifying both the client system's PC compatibility for the requested copy of at least one software file and that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file; and  
scheduling the download of the requested software from a **staging server to the client system. [5]**  
(indicator numbers added)

Claim 11:

...  
receiving an order entitlement ID for at least one software file, which has been previously ordered from a client system on a software ordering server; **[3b]**  
storing the entitlement ID for at least one software file in a database;  
receiving a request for the down-load of at least one requested software file with a download entitlement ID from a client system; **[4]**  
determining if the download entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID, scheduling a response to the request for a copy of the at least one software file at a scheduling server. **[5]**  
(indicator numbers added)

Claim 12:

...  
presenting to a user a list of software for installation on a client system; **[1]**  
receiving a user selection for ordering at least one software file from the list of software on a software ordering server; **[2]**

receiving a response to the order for at least one software file from the software ordering server, the response includes an entitlement ID for authorizing the installation of the software file, wherein the entitlement ID is sent from the software ordering server to the software delivery server; **[3a & 3b]**

requesting a download copy of the at least one software file from the software delivery server, the request includes the entitlement ID previously received from the software ordering server; **[4]**

receiving, in response to the entitlement ID received from the software ordering server matching the entitlement ID received with a request for the download copy, the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script; and **[5]**

installing the received copy of the at least one software file.  
(indicator numbers added)

Claim 15:

...  
receiving an entitlement ID for at least one software file, which has been previously ordered from a client system on a software ordering server; **[3b]**

storing the entitlement ID for at least one software file in a database;

receiving a request for the download of at least one requested software file with a download entitlement ID from a client system; and **[4]**

determining if the download entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID, scheduling a response to the request for a copy of the at least one software file at a scheduling server. **[5]**  
(indicator numbers added)

Claim 17:

...  
a network interface for coupling at least one client system;  
an order entitlement ID received over the network interface for at least one software file, which has been previously ordered by the at least one client system on a software ordering server;  
**[3b]**

a database used to store the entitlement ID for at least one software file;

a download request received over the network interface from at least one of the one or more client systems for a copy of the at

least one software file, wherein the request includes an order entitlement ID for at least one software file; and [4]

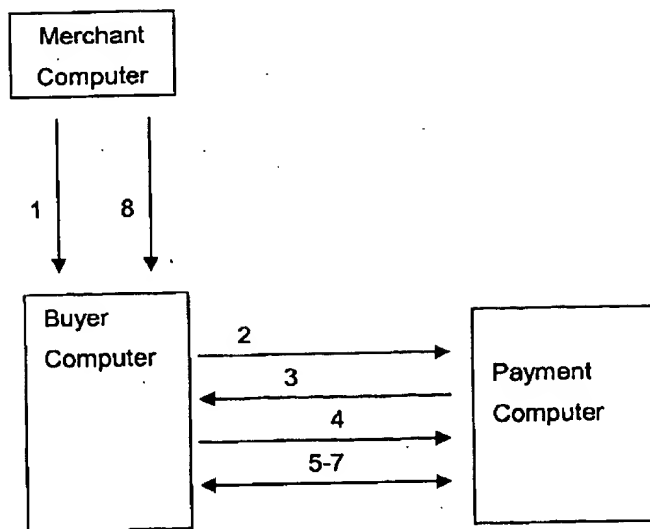
means for determining if the entitlement ID received from the client system matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID received from the client system matching the previously stored entitlement ID, scheduling a response to the request for a copy of the at least one software file at a scheduling server. [5]  
(indicator numbers added)

(8-9) Rejection under 35 U.S.C. §103(a) Payne et al. in view of Fawcett

As noted above, the Examiner rejected claims 1, 3-12, 14, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Payne et al. (U.S. Patent No. 5,715,314) in view of Fawcett (U.S. Patent No. 5,845,077).

The Payne reference discloses a network-based sales system that includes a buyer computer, a merchant computer, and a payment computer. Payne "provides a simple design architecture for the network sales system that allows the merchant computer to respond to payment orders from the buyer computer **without the merchant computer having to communicate directly with the payment computer** to ensure that the user is authorized to purchase the product and without the merchant computer having to store information in a database regarding which buyers are authorized to purchase which products. Rather, when the merchant computer receives an access message from the buyer computer identifying a product to be purchased, the merchant computer need only check the access message to ensure that it was created by the payment computer (thereby establishing for the merchant computer that the buyer is authorized to purchase the product), and then **the merchant computer can cause the product to be sent to the buyer computer** who has been authorized to purchase the product." Payne, col. 2, lines 3-18.

The following figure graphically shows what is disclosed in the flow diagram in FIG. 2 of Payne, as well as the corresponding sections of the disclosure. It is submitted that the following figure shows how the Payne system is dissimilar to the present invention.



In the first step, the "merchant computer sends advertising document to buyer computer." *Payne*, FIG. 2A, step 30. Next, in step 2, a purchase instruction is not sent back to the merchant computer, as is done with the present invention, but instead, the buyer computer in *Payne* sends purchasing information to a **purchasing computer**. *Payne*, FIG. 2A, step 34. In step 3, the payment computer sends a confirmation of receiving the purchase information back to the buyer computer. *Payne*, FIG. 2C, step 44. In step 4, the buyer computer sends payment information to the payment computer. *Payne*, FIG. 2C, step 62. In the subsequent steps (steps 5-7 in the figure above and steps 62, 64, 66, 68, 70, 72, 73, 82, 76, 80, 88, 90, among others in FIG. 2 of *Payne*) the buyer computer and purchasing computer interact without involving the merchant computer at all. Finally, and again in contrast to the present invention, after the repeated correspondence between the buyer computer and the purchasing computer in *Payne* (steps 92, 94, 98, 101, 102, and 104 of FIG. 2 of *Payne*), the merchant computer sends a fulfillment document to the buyer computer (step 8 above).

As claimed in the present invention, the software is delivered by the software delivery server and **not by the merchant computer**, as is done in *Payne*. In this way, *Payne* actually *teaches away* from the present invention. A model where the vendor (merchant computer) delivers the requested item to target workstations does not work well in an enterprise software delivery application that needs to perform standard

delivery of software to hundreds of thousands of customer workstations located around the world. The present invention allows for the presence of hundreds of software "staging servers" located around the world which will efficiently perform the installation. Prior art that *teaches away* is per se demonstration of lack of *prima facie* obviousness.<sup>1</sup>

Clearly, Payne does not show "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the software delivery server**" or "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" as recited in amended claim 1 of the instant application.

The Fawcett reference describes Microsoft's Windows Update Function. The function clearly works well for delivering "Microsoft software" products, patches, etc. to Windows clients. However, Fawcett, like Payne does not teach or suggest the limitations of "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the software delivery server**" and for "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script" as claimed in the present invention.

When there is no suggestion or teaching in the prior art for "receiving a response to the order for at least one software file **from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the software delivery server**" and for "receiving...the copy of the at least one software file **from a staging server** as part of a payload containing at least one customized installation script," the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5

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<sup>1</sup> See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)

USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Payne taken alone and/or in view of Fawcett does not even suggest, teach or mention the client/server network of the present invention. Accordingly, claims 1-15 and 17 distinguish over Payne taken alone and/or in view of Fawcett for this reason as well.

(10) Rejection under 35 U.S.C. §103(a) Payne et al. in view of  
Fawcett and further in view of Klemba

As noted above, the Examiner rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Payne et al. (U.S. Patent No. 5,715,314) in view of Fawcett (U.S. Patent No. 5,845,077), and further in view of Klemba (U.S. Patent Publication 2002/0128975).

For reasons stated above in the section entitled "Rejection under 35 U.S.C. §103(a) Payne in view of Fawcett", Payne taken alone taken alone and/or in view of Fawcett are silent on "receiving a response to the order for at least one software file from the software ordering server...wherein the entitlement ID is sent from the software ordering server to the software delivery server" and for "receiving...the copy of the at least one software file from a staging server as part of a payload containing at least one customized installation script."

Claims 2 and 13 depend from independent claims 1 and 12, respectively. Since dependent claims contain all of the limitations of the independent claims from which they depend, it is accordingly believed to be clear that Payne et al., whether taken alone or in any combination with Fawcett and/or Klemba, neither shows nor suggests the features of claims 2 or 13. Claims 2 and 13 are, therefore, believed to be patentable over the art.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

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In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

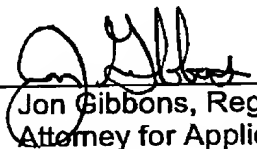
Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: May 10, 2005

By:



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